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EXAMINER

SEO, JUSTIN

ART UNIT

PAPER NUMBER

2861

MAIL DATE

DELIVERY MODE

03/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to an apparatus for printing, classified in class 347, subclass 2.
 - II. Claims 8-12, drawn to a machine for printing images, classified in class 101, subclass 35.
 - III. Claim 13, drawn to a method of printing, classified in class 101, subclass 407.1.
 - IV. Claims 14-17, drawn to jet-printing apparatus, classified in class 347, subclass 5.
 - V. Claim 18-20, drawn to a jet-printing apparatus, classified in class 347, subclass 84.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I/II/IV/V and III are related as process (III) and apparatus (I/II/IV/V) for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as printing a visual image on food without linearly displacing at least one tray.

3. Inventions I/II and IV/V are related as combination (I/II) and subcombination (IV/V). Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the printing apparatus of the combination does not have to specifically be of the jet-printing type. For example, the printing apparatus of the combination can be of the thermal type or stamping type. The subcombination has separate utility such as allowing for color printing.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in

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accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, invention I has separate utility such as an apparatus for printing comprising a computer without at least one support roller (II), and vice versa. In other words, each one of the inventions recited in Group I and Group II is separately usable in a system not having the other. See MPEP § 806.05(d).

5. Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, invention IV has separate utility such as a jet-printing apparatus with an automatic mode without a plurality of cartridges (V), and vice versa. In other words, each one of the inventions recited in Group IV and Group V is separately usable in a system not having the other. See MPEP § 806.05(d).

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election

shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Upon election of invention I, II, III, IV or V, the applicant is further required under 35 U.S.C. 121 to elect on of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable (currently, no claims are generic):

(A) The embodiment of Fig. 4.

(B) The embodiment of Fig. 6.

7. Upon election of invention I and any combination of its species stated above, the applicant is further required under 35 U.S.C. 121 to elect on of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable (currently, no claims are generic):

(Ia) wherein the guide mechanism further includes 2 gears (for example claim 4)

(Ib) wherein the guide mechanism further includes 1 gear (for example claim 5)

8. Upon election of invention II and any combination of its species stated above, the applicant is further required under 35 U.S.C. 121 to elect on of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable (currently, no claims are generic):

(IIa) wherein the guide mechanism further includes 2 gears (for example claim 10)

(IIb) wherein the guide mechanism further includes 1 gear (for example claim 11)

9. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement (e.g., I, A, Ia and IIa), and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN SEO whose telephone number is (571)270-1327. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Luu can be reached on 571-272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LUU MATTHEW/
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Unit 2861

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March 19, 2008